

Request for Reconsideration after Final Action

The table below presents the data as entered.

Input Field	Entered
SERIAL NUMBER	85544660
LAW OFFICE ASSIGNED	LAW OFFICE 110
MARK SECTION (no change)	
ARGUMENT(S)	
<p>The Examiner has refused registration opining that the instant mark is “deceptively misdescriptive” [1] of Applicant’s identified goods in class 3 and “consists of or includes deceptive matter”[2] in relation to Applicant’s identified goods in class 5. Based on the these remarks and the identified attachments, Applicant respectfully requests that the Examiner reconsider the application, withdraw the refusal to register and allow the application to proceed to publication.</p> <p>In support of the refusal, Examiner has defined CoCoa as “[a] powder made from cacao seeds after they have been fermented, roasted, shelled, ground, and freed of most of their fat.” [3] However, the word has more than one definition; cocoa is also a beverage prepared by heating cocoa with water or milk[4] and it is also used to describe a color. This last definition is utilized by Applicant in its unitary mark, COCOA SUNCARE. Applicant uses the word, COCOA, to suggest the color of “tanned skin.”</p> <p>As previously stated, Applicant is not the first to use the term COCOA to suggest a color. The Office has accepted the term COCOA when used as a color description in connection with products in Class 3. Specifically, U. S. Registration No. 3976864, for COCOA TAN, used in connection with cosmetic suntan lotions (copy attached) and U.S. Registration No. 3525119, for INSTANT COCOA, for used in connection with hair color (copy attached). Just as others use the term COCOA to suggest a color, Applicant’s mark suggests the color of beautiful “tanned skin”. The registration of the mark COCOA TAN for use on cosmetic suntan lotions clearly shows accepted practice in the Office.</p> <p>In addition, Applicant respectfully disagrees with the notion that it is reasonable for consumers to believe that Applicant’s goods, sold under the mark COCOA SUNCARE, contain “a powder made from cacao seeds after they have been fermented, roasted, shelled, ground, and freed of most of their fat.” If anything, the listing of products attached to the July 3, 2013 Office Action indicates that products which contain the substance cocoa butter, are marketed with that exact phrase, and not the single word cocoa, which is given to multiple definitions.</p> <p>During prosecution Examiner has opined that since some personal care products contain “cocoa butter” then consumers would be likely to believe that Applicant’s products, sold under the mark COCOA SUNCARE contain cocoa. This is not possible based on Examiner's own definition of the word COCOA, “a powder made from cacao seeds” which specifically excludes cocoa butter. Cocoa butter is defined as a pale vegetable fat with a low melting point obtained from cacao beans.[5]</p>	

As the term COCOA in Applicant's mark is not a term that "misdescribes the character, quality, function, composition, or use of the goods" and the registration of other marks containing the term COCOA, such as COCOA TAN and INSTANT COCOA, indicates that the purchasers have been exposed to the use of the term COCOA as a description of color in both similar and dissimilar products, it is not likely that prospective purchasers would believe Applicant's goods contain "a powder made from cacao seeds after they have been fermented, roasted, shelled, ground, and freed of most of their fat" as the Examiner has defined cocoa.

Based on the foregoing remarks and the cited registrations, Applicant respectfully requests that the refusal to register the instant mark be reconsidered and withdrawn and that the application be allowed to proceed.

It is requested that the undersigned be contacted with any questions.

Respectfully submitted,

/Kathleen A. Costigan/

Kathleen A. Costigan

[1] See July 3, 2014 Office Action at page 1.

[2] See July 3, 2014 Office Action at page 3.

[3] See July 3, 2014 Office Action at page 2.

[4] See Applicant's October 31, 2012 response, Exhibit A

[5] See Applicant's October 31, 2012 response, Exhibit A.

EVIDENCE SECTION

EVIDENCE FILE NAME(S)	
ORIGINAL PDF FILE	evi_6786120194-230508506_.1011-TM-1272_US3525119.pdf
CONVERTED PDF FILE(S) (1 page)	\\TICRS\EXPORT16\IMAGEOUT16\855\446\85544660\xml13\RFR0002.JPG
ORIGINAL PDF FILE	evi_6786120194-230508506_.1011-TM-1272_US3976864.pdf
CONVERTED PDF FILE(S) (1 page)	\\TICRS\EXPORT16\IMAGEOUT16\855\446\85544660\xml13\RFR0003.JPG
DESCRIPTION OF EVIDENCE FILE	US TM REGISTRATION NOS.3976864, 3525119

SIGNATURE SECTION	
RESPONSE SIGNATURE	/Kathleen A. Costigan/
SIGNATORY'S NAME	Kathleen A. Costigan
SIGNATORY'S POSITION	Attorney for Applicant, NY bar member.
SIGNATORY'S PHONE NUMBER	212-302-8989
DATE SIGNED	07/28/2014
AUTHORIZED SIGNATORY	YES
CONCURRENT APPEAL NOTICE FILED	YES
FILING INFORMATION SECTION	
SUBMIT DATE	Mon Jul 28 23:47:20 EDT 2014
TEAS STAMP	USPTO/RFR-67.86.120.194-2 0140728234720026570-85544 660-500f82138f7249b178143 faae9a758e2de9871ba2347bc d0515821c44e9077f236-N/A- N/A-20140728230508506234

Request for Reconsideration after Final Action To the Commissioner for Trademarks:

Application serial no. **85544660** has been amended as follows:

ARGUMENT(S)

In response to the substantive refusal(s), please note the following:

The Examiner has refused registration opining that the instant mark is “deceptively misdescriptive” [1] of Applicant’s identified goods in class 3 and “consists of or includes deceptive matter”[2] in relation to Applicant’s identified goods in class 5. Based on the these remarks and the identified attachments, Applicant respectfully requests that the Examiner reconsider the application, withdraw the refusal to register and allow the application to proceed to publication.

In support of the refusal, Examiner has defined CoCoa as “[a] powder made from cacao seeds after they

have been fermented, roasted, shelled, ground, and freed of most of their fat.” [3] However, the word has more than one definition; cocoa is also a beverage prepared by heating cocoa with water or milk[4] and it is also used to describe a color. This last definition is utilized by Applicant in its unitary mark, COCOA SUNCARE. Applicant uses the word, COCOA, to suggest the color of “tanned skin.”

As previously stated, Applicant is not the first to use the term COCOA to suggest a color. The Office has accepted the term COCOA when used as a color description in connection with products in Class 3. Specifically, U. S. Registration No. 3976864, for COCOA TAN, used in connection with cosmetic suntan lotions (copy attached) and U.S. Registration No. 3525119, for INSTANT COCOA, for used in connection with hair color (copy attached). Just as others use the term COCOA to suggest a color, Applicant’s mark suggests the color of beautiful “tanned skin”. The registration of the mark COCOA TAN for use on cosmetic suntan lotions clearly shows accepted practice in the Office.

In addition, Applicant respectfully disagrees with the notion that it is reasonable for consumers to believe that Applicant’s goods, sold under the mark COCOA SUNCARE, contain “a powder made from cacao seeds after they have been fermented, roasted, shelled, ground, and freed of most of their fat.” If anything, the listing of products attached to the July 3, 2013 Office Action indicates that products which contain the substance cocoa butter, are marketed with that exact phrase, and not the single word cocoa, which is given to multiple definitions.

During prosecution Examiner has opined that since some personal care products contain “cocoa butter” then consumers would be likely to believe that Applicant’s products, sold under the mark COCOA SUNCARE contain cocoa. This is not possible based on Examiner’s own definition of the word COCOA, “a powder made from cacao seeds” which specifically excludes cocoa butter. Cocoa butter is defined as a pale vegetable fat with a low melting point obtained from cacao beans.[5]

As the term COCOA in Applicant’s mark is not a term that “misdescribes the character, quality, function, composition, or use of the goods” and the registration of other marks containing the term COCOA, such as COCOA TAN and INSTANT COCOA, indicates that the purchasers have been exposed to the use of the term COCOA as a description of color in both similar and dissimilar products, it is not likely that prospective purchasers would believe Applicant’s goods contain “a powder made from cacao seeds after they have been fermented, roasted, shelled, ground, and freed of most of their fat” as the Examiner has defined cocoa.

Based on the foregoing remarks and the cited registrations, Applicant respectfully requests that the refusal to register the instant mark be reconsidered and withdrawn and that the application be allowed to proceed.

It is requested that the undersigned be contacted with any questions.

Respectfully submitted,

/Kathleen A. Costigan/

Kathleen A. Costigan

[1] See July 3, 2014 Office Action at page 1.

[2] See July 3, 2014 Office Action at page 3.

[3] See July 3, 2014 Office Action at page 2.

[4] See Applicant's October 31, 2012 response, Exhibit A

[5] See Applicant's October 31, 2012 response, Exhibit A.

EVIDENCE

Evidence in the nature of US TM REGISTRATION NOS.3976864, 3525119 has been attached.

Original PDF file:

[evi_6786120194-230508506_.1011-TM-1272_US3525119.pdf](#)

Converted PDF file(s) (1 page)

[Evidence-1](#)

Original PDF file:

[evi_6786120194-230508506_.1011-TM-1272_US3976864.pdf](#)

Converted PDF file(s) (1 page)

[Evidence-1](#)

SIGNATURE(S)

Request for Reconsideration Signature

Signature: /Kathleen A. Costigan/ Date: 07/28/2014

Signatory's Name: Kathleen A. Costigan

Signatory's Position: Attorney for Applicant, NY bar member.

Signatory's Phone Number: 212-302-8989

The signatory has confirmed that he/she is an attorney who is a member in good standing of the bar of the highest court of a U.S. state, which includes the District of Columbia, Puerto Rico, and other federal territories and possessions; and he/she is currently the applicant's attorney or an associate thereof; and to the best of his/her knowledge, if prior to his/her appointment another U.S. attorney or a Canadian attorney/agent not currently associated with his/her company/firm previously represented the applicant in this matter: (1) the applicant has filed or is concurrently filing a signed revocation of or substitute power of attorney with the USPTO; (2) the USPTO has granted the request of the prior representative to withdraw; (3) the applicant has filed a power of attorney appointing him/her in this matter; or (4) the applicant's appointed U.S. attorney or Canadian attorney/agent has filed a power of attorney appointing him/her as an associate attorney in this matter.

The applicant is filing a Notice of Appeal in conjunction with this Request for Reconsideration.

Serial Number: 85544660

Internet Transmission Date: Mon Jul 28 23:47:20 EDT 2014

TEAS Stamp: USPTO/RFR-67.86.120.194-2014072823472002

6570-85544660-500f82138f7249b178143faae9

a758e2de9871ba2347bcd0515821c44e9077f236

-N/A-N/A-20140728230508506234

Int. Cl.: 3

Prior U.S. Cls.: 1, 4, 6, 50, 51, and 52

United States Patent and Trademark Office

Reg. No. 3,525,119

Registered Oct. 28, 2008

**TRADEMARK
PRINCIPAL REGISTER**

INSTANT COCOA

THE PROCTER & GAMBLE COMPANY (OHIO
CORPORATION)
ONE PROCTER & GAMBLE COMPANY
CINCINNATI, OH 45202

THE MARK CONSISTS OF STANDARD CHAR-
ACTERS WITHOUT CLAIM TO ANY PARTICULAR
FONT, STYLE, SIZE, OR COLOR.

FOR: HAIR COLOR, IN CLASS 3 (U.S. CLS. 1, 4, 6,
50, 51 AND 52).

SN 77-213,263, FILED 6-22-2007.

FIRST USE 1-2-2008; IN COMMERCE 1-2-2008.

ANGELA M. MICHELI, EXAMINING ATTORNEY

United States of America

United States Patent and Trademark Office

COCOA TAN

Reg. No. 3,976,864

Registered June 14, 2011

Int. Cl.: 3

TRADEMARK

PRINCIPAL REGISTER

JLW-TW CORP (OHIO CORPORATION)
35350 CHESTER RD.
AVON, OH 44011

FOR: COSMETIC SUNTAN LOTIONS, IN CLASS 3 (U.S. CLS. 1, 4, 6, 50, 51 AND 52).

FIRST USE 6-4-2010; IN COMMERCE 6-4-2010.

THE MARK CONSISTS OF STANDARD CHARACTERS WITHOUT CLAIM TO ANY PARTICULAR FONT, STYLE, SIZE, OR COLOR.

SER. NO. 85-059,906, FILED 6-10-2010.

JANET LEE, EXAMINING ATTORNEY



David J. Kappas

Director of the United States Patent and Trademark Office